

II. FINALITY – IMPROPERLY IMPOSED

Further, the Office Action is not properly made final under MPEP 706.07(b), which provides:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

According to the Office Action, claims 1-19 are withdrawn for being directed to a non-elected species of invention. Thus, the present claims could not satisfy (B)(1) of MPEP 706.07(b), which is a requirement that must be satisfied to warrant finality of the claim rejection in the first Office Action. Further, the requirement of (B)(2) is not met since there has not been any examination on the merits for the pending claims. As a result, the Examiner was unaware as to whether the pending claims would have been properly finally rejected on the grounds and art of record if they had been entered in the earlier application.

Therefore, the rendering of a finality designation was improper and warrants withdrawal.

Respectfully submitted,

Robert Hess
Robert Hess, Reg. No. 32,139

Hess Patent Law Firm, PC
9 Miramar Lane, Stamford, CT 06902
phone 203 356-0727